

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-8, 10-27 and 29-41 are presently active in this case, Claim 19 amended by way of the present amendment.

In the outstanding Official Action, Claim 19 was objected to; Claims 1-5, 7-8, 14-15, 18-24, 26-27, 33-34, 37-38 and 40 were rejected under 35 U.S.C. § 102(e) as being anticipated by Patent Publication No. U.S. 2004/0254911 to Grasso et al.; and Claims 6 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grasso et al. and further in view of Official Notice.

With regard to the objection to Claim 19, Applicants have amended this claim to overcome the objection.

Turning now to the merits, Applicants' invention is directed to a system and method for easily storing document information in an application service provider (ASP). As described in the background section of Applicants' specification, homeowners and businesses are frequently turning to ASPs for offsite storage of important documents.¹ However, ASPs conventionally require a user to interface with complex menus on the ASP site in order to store a document.² This can be time consuming and frustrating, particularly to a user unfamiliar with the ASP site. Applicants' invention is directed to simplifying the ASP storage process. Specifically, independent Claims 1, 10 and 12 recite a method of storing document information in an application service provider (ASP) which is connected to a user terminal through a network. The method includes inputting the document information into the user terminal, and inputting a previously created e-mail address into the user terminal, the e-mail address being confirmed by the ASP and corresponding to a storage location in a

¹ Applicants' specification at paragraph [0002].

² Applicants' specification at paragraph [0003].

document database of the ASP. Also recited is sending the document information to the e-mail address via the network so that the ASP can store document information at the storage location in the document database. Independent claims 20, 29, 31 and 38 recite similar limitations in system and means plus function format.

To establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must describe each and every element as set forth in the subject claim.³ The identical invention must be shown in as complete detail as is contained in the ... claim.⁴ Moreover, as required by M.P.E.P. § 2143.03, "All words in the claim must be considered in judging the patentability of that claim against the prior art." Applicants respectfully submit that the cited reference to Grasso et al. fails to teach each and every limitation of independent Claims 1, 10, 12, 20, 29, 31 or 38.

Grasso et al. discloses a system and method for providing document recommendations to a user. For example, where a user prints a database document that is relevant to a work project performed by the user, the database may include other documents unknown to the user but relevant to the work project. The system of Grasso et al. identifies these other relevant documents and recommends such documents to the user. As discussed in Grasso et al., the recommendation can be generated based on various recommendation criteria.⁵ Further, in the embodiment of the invention shown in Figures 2 and 3, the recommendation services are provided on a remote service provider 210 which also offers various services such as processing print requests for user printer 112, and storing documents that are scanned by the user scanner 410. However, there is no indication in Grasso et al. of the claimed features relating to storage of documents to the service provider 210 via e-mail.

The outstanding Official Action cites paragraphs 7 and 34 of Grasso et al. as meeting the e-mail limitations of Applicants' independent claims. However, paragraph 7 of Grasso et

³ *Verdegaal Bro. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁴ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 1913, 1920 (Fed. Cir. 1989).

⁵ Grasso et al. at paragraph [0027].

al. merely mentions that the services offered by network office appliances may include e-mail services. Similarly, paragraph 34 of Grasso et al. includes only a tangential reference to the e-mail interface in the context of collecting implicit ratings of documents from users. These paragraphs include the only two uses of the term “e-mail” in Grasso et al.. In fact, Grasso et al. makes clear that the printer 112 and scanner 110 exchange information with the service provider 210 by way of a direct network connection rather than by way of e-mail. Specifically, Grasso et al. discloses that the user accesses a web site of the service provider 210⁶ and the service provider 210 must have network access to the printer 112.⁷ Further, Grasso et al. explains that the service provider can provide an XML interface through which document content and user requests can be passed between the user interface and the server.⁸

Thus, Grasso et al. in no way teaches or suggests “inputting a previously created e-mail address into a user terminal, the e-mail address being confirmed by the ASP and corresponding to a storage location in a document database of the ASP,” or “sending the document information to the e-mail address so that the ASP can store the document as required information at the storage location in the document database” as required by claims 1, 10, 12, 20, 29, 31 and 38. On the contrary, Grasso et al. suggests a direct network connection to provide remote services via the internet. Without the claimed e-mail features of the present invention, Grasso et al. does not provide the simple ASP storage method and system to which Applicants claims are directed.

Thus, independent Claims 1, 10, 12, 20, 29, 31 and 38 patentably define over the cited reference to Grasso et al. Moreover, as the remaining pending claims in this case depend from one of the distinguished independent claims, these dependent claims also patentably define over the cited references.

⁶ See Grasso et al. at paragraph [0059].

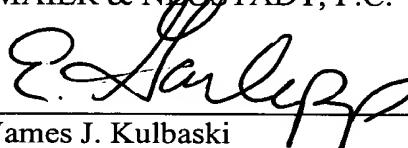
⁷ See Grasso et al. at paragraph [0061].

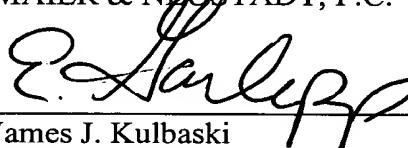
⁸ See Grasso et al. at paragraph [0064].

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


James J. Kulbaski
Registration No. 34,648


Edwin D. Garlepp
Registration No. 45,330

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

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